

REMARKS

I. STATUS OF CLAIMS

The Office Action dated April 7, 2008, refers to the Office Action dated March 9, 2006 for its substantive content. Thus, the current remarks address the latter. Claims 1-10 are currently pending upon entry of this Amendment. Claims 11-26, previously withdrawn from consideration as being directed to non-elected species in the Response to Restriction Requirement filed on August 19, 2003, have been canceled. Claims 1-10 stand rejected. Entry of the Amendment After Final Rejection is considered proper as the Amendment merely cancels claims and simplifies the issues for Appeal.

I. OBVIOUSNESS REJECTION UNDER 35 U.S.C. § 103

Claims 1-10 have been rejected under 35 U.S.C. § 103 over Positive Pay in view of U.S. Patent Publication Number 2001/0037315 to Saliba et al. (hereinafter “Saliba”). This rejection is respectfully traversed.

A. The Combination of Positive Pay and Saliba fails disclose the claimed features

Even if combined, Positive Pay and Saliba fail to disclose the features of independent claims 1 and 10. In summary, the Office Action fails to establish a *prima facie* case of obviousness. Specifically, before considering what would be obvious to one of ordinary skill in the art at the time of the invention, the art must teach or suggest the claim limitations. See MPEP §2143.

Positive pay fails to disclose “receiving a presentment check file, said presentment check file including presentment information related to checks presented to a payor financial institution for payment” as required by claim 1. Specifically, in Positive Pay, each presented check is evaluated and compared to an issue file on a check-by-check basis. No presentment file is implemented. Claim 1 requires that a presentment file be received that is related to multiple checks for payment. Thus, based on this clause, at least two features of claim 1 are absent from Positive Pay. First, Positive Pay fails to disclose reception of a presentment file. Instead, in Positive Pay, the system merely receives the check or an image of the check itself. Secondly, in Positive Pay, even if the Examiner were to interpret the reference to consider the check itself as a presentment file, the presentment file would not relate to multiple checks presented as required by claims 1 and 10.

Additionally, Positive Pay fails to disclose a third feature of “comparing said presentment check file with said payor check file thereby producing at least one exception item” as required by claim 1. As set forth above, Positive pay compares a payor check file with each check presented on a check-by-check basis. Positive Pay does not disclose a presentment check file which is compared with a payor check file to produce at least one exception item.

Further, as acknowledged in the Office Action, the Positive Pay reference fails to disclose a fourth feature of claim 1, which includes sending said exception client an e-mail notifying said exception client of said at least one exception item.

With respect to claim 10, Positive Pay also fails to disclose generating a Web file, said Web file including an image relating to said exception item and sending said exception client an e-mail notifying said exception client of said at least one exception item. Positive Pay further

fails to disclose generating an address for said Web file, wherein said e-mail address includes a hyperlink to said address.

Saliba fails to obviate the deficiencies of Positive Pay as set forth above. Saliba does not teach or disclose a method in a check exception item notification system for producing an exception item by a payor financial institution. Saliba also fails to disclose receiving a presentment check file by said payor financial institution, said presentment check file including presentment information relating to checks presented to said payor financial institution for payment. Saliba also fails to disclose receiving a payor check file from said exception client by said payor financial institution, said payor check file including check information relating to checks written by said exception client. Additionally, Saliba fails to disclose comparing said presentment check file with said payor check file by said payor financial institution thereby producing at least one exception item. Finally, Saliba also fails to disclose sending said exception client an e-mail by said payor financial institution.

In order to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970); *In re Edward S. Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994)

Thus, because the references do not include each and every feature of claims 1 and 10, a *prima facie* case of obviousness has not been established. Claims 2-9 depend from claim 1 and include further distinctive features not disclosed in the applied references. Thus, claims 2-9 define over the art of record for at least the reasons set forth above in relation to claim 1.

B. Lack of Motivation to Combine

Applicant respectfully submits that the Examiner improperly assumes that the combination asserted in claims 1 and 10 would be desired. On page 4 of the Office Action mailed on 3/9/06, the Examiner states that he “believes that it would have been obvious for one skilled in the art to have looked at the secondary reference as a means for further automating the positive pay system”. However, the PTO has the burden to establish that the prior art taken as a whole suggests the desirability of the combination. Here, rather than evaluating any suggestion in the reference, the Examiner himself assumes the combination would have been obvious by asserting that automation is “well known”. However, the Examiner fails to explain why the art would suggest an email notification specifically for a check exception item. Thus, applicant submits that the Examiner’s assumption is improper.

Second, Applicant submits that the Examiner’s assertion of motivation is lacking in evidence. Instead of evidence, the Examiner improperly relies on his own hindsight conjecture that the step of emailing is well-known and obvious. For example, the motivation cited by the Examiner to combine the references is nowhere to be found in either the Positive Pay or Saliba references. Even assuming that the motivation is applicable, Positive Pay makes no suggestion that it would benefit from the teachings of Saliba. For example, Positive Pay is concerned with fraud detection, specifically the verification of checks, whereas Saliba is primarily concerned with secure transmission of information such as bill data and financial account information. Therefore, the person of ordinary skill would not likely be motivated to combine teachings from these disparate references to arrive at applicant’s invention.

As a result, the Examiner's statement that Positive Pay "can benefit" from Saliba is wholly unsupported. In short, the assertion that a primary reference purportedly "can benefit" from a secondary reference does not constitute specific motivation or suggestion for the combination. The inquiry is not whether, in post hoc fashion, one reference "might benefit" from another. Rather, the inquiry is whether the prior art provides specific motivation to select the second reference and combine it with the first. The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007). Therefore, applicants respectfully submit that the combination of Positive Pay and Saliba would not have been obvious to one of ordinary skill in the art at the time of the invention and that the Examiner's conclusion is clearly based on improper hindsight reasoning. Thus, the Examiner has failed to set forth a *prima facie* case of obviousness. For at least the reasons discussed above, the obviousness rejection is improper and should be withdrawn.

II. CONCLUSION


Thus, for the reasons set forth above, claims 1-10 define over the art of record and an obviousness rejection cannot be sustained.

As set forth above, applicant respectfully submits that all claims are in condition for allowance. Withdrawal of all rejections and prompt passage to issuance are earnestly requested. In the event Applicants have overlooked the need for an extension of time, payment of fee, or additional payment of fee, Applicants hereby petition therefore and authorize that any charges be made to Deposit Account No. 50-4494.

Should the Examiner have any questions regarding any of the above, the Examiner is respectfully requested to telephone the undersigned at 202-346-4016.

Respectfully submitted,

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